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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

MAIORINO, ROZ

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3763

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,697

Applicant(s)

PEPIN, HENRY J.

Examiner

Roz Maiorino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 11-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No.6240231 to Ferrera et al.

Catheter shaft including an inner member defining an outer surface thereon; and a first layer disposed over at least a portion of the outer surface of the inner member, the first layer including a selectively curable material, the selectively curable material at least partially cured at desired portion thereof to later the flexibility of the support member at the desired portion. The first layer could contain epoxy or Ultraviolet cured. (Col.4, lines1-10)

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No 5836925 to Soltesz.

Catheter shaft including an inner member defining an outer surface thereon; and a first layer disposed over at least a portion of the outer surface of the inner member, the first

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layer including a selectively curable material, the selectively curable material at least partially cured at desired porting thereof to later the flexibility of the support member at the desired portion.

3. Claims 1, 4-6 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No.6562021 to Derbin et al.

Catheter shaft including an inner member defining an outer surface thereon; and a first layer disposed over at least a portion of the outer surface of the inner member, the first layer including a selectively curable material, the selectively curable material at least partially cured at desired porting thereof to later the flexibility of the support member at the desired portion. The first layer could contain ultraviolet cured. (Col.8, lines 35-50) The second layer includes a first wire ribbon, which is wound in a helical pattern in a first direction. (Col.11, lines 10-30)

4. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No.5897537 to Berg et al.

Catheter shaft including an inner member defining an outer surface thereon; and a first layer disposed over at least a portion of the outer surface of the inner member, the first layer including a selectively curable material, the selectively curable material at least partially cured at desired porting thereof to later the flexibility of the support member at the desired portion. The first layer could contain ultraviolet cured. The second layer includes a first wire ribbon, which is wound in a helical pattern in a first direction.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent No.6240231 to Ferrera et al or US Patent No.6562021 to Derbin et al or US Patent No.5897537 to Berg et al

As mentioned above both Ferrera, Berg, and Derbin all teach the invention except for fourth and fifth layers to the catheter shaft. However it would have been obvious to have duplicated part for a multiple effect such as better flexibility range-In re Haraza, 274 F.2d 669, 671, 124 USPQ 378, 380 (CCPA 1960)

6. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent No.6240231 to Ferrera et al or US Patent No.6562021 to Derbin et al or US Patent No.5897537 to Berg et al or US Patent no. 5836925 to Soltez.

As mentioned above both Ferrera, Berg, Soltez and Derbin all teach the invention except for fourth and fifth layers to the catheter shaft. However it would have been obvious to have duplicated part for a multiple effect such as better flexibility range-In re Haraza, 274 F.2d 669, 671, 124 USPQ 378, 380 (CCPA 1960)

Response to Arguments

7. Applicant's arguments filed 10-6-2003 have been fully considered but they are not persuasive.

a. The applicant has claimed the process of making the catheter: "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted)

b. Even if the examiner does consider the product by process argument, the argument is moot due to the new art added.

c. Applicant claims that Ferrera does not teach a first layer with different portions which demonstrated different flexibility. However applicant is incorrect, the limitation is written broadly and is not restricting the first layer to only have one thickness since the applicant has elected the word comprising the first layer can have different thickness. As demonstrated in figure 4 in Ferrera sections 7, 6 and 5 are all a first layer with different thickness, which demonstrated different flexibility. And as mentioned above the process of which the tube becomes flexible (i.e. The curing) falls under process by product.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roz Maiorino whose telephone number is 703-305-2336. The examiner can normally be reached on 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RM



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